



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1 1990)
2000 GALLOPING HILL RD
KENILWORTH NJ 07033

COPY MAILED

APR 19 2006

OFFICE OF PETITIONS

In re Application	:
Briegs, et al.	:
Application No. 09/655,667	: DECISION ON APPLICATION
Filed: September 6, 2000	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. ID01065Q	:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705", filed February 27, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from eight hundred fifty-four (854) days to nine hundred thirty-one (931) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein. However, applicants' request that an additional PTO delay of seventy-two (72) days be assessed is being **HELD IN ABEYANCE** until after the actual patent date.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicant's written request for reconsideration.

On November 25, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is eight hundred fifty-four (854) days. On February 27, 2006, applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is nine hundred thirty-one (931) days.

Applicants state that the patent issuing from the application is subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of eight hundred fifty-four (854) days based on an adjustment for PTO delay of four hundred fifty-eight (458) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), twenty-nine (29) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(3), and four hundred thirty-five (435) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(b)(4), reduced by applicants' delays of two (2) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b) and sixty-six (66) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8). All adjustments have been reviewed and found to be correct.

However, a review of the file reveals that applicants should have been assessed additional delay of four (4) days pursuant to 37 C.F.R. 1.704(b). The Office mailed a Notice to File Missing Parts on October 18, 2000. Applicants did not file a complete response until January 22, 2001. Accordingly, four (4) days of applicant delay should have been assessed.

In addition, a review of the file reveals that the Office should have been assessed fifty (50) days of delay pursuant to 35 U.S.C. 154(b)(1)(A)(iii) and 37 C.F.R. § 1.703(a)(5). A BPAI decision was mailed on June 6, 2005, reversing the examiner. The Office did not act until the mailing of a Notice of Allowance on November 25, 2005. Accordingly, fifty (50) days of PTO delay should have been assessed.

Lastly, applicants assert additional PTO delay of seventy-two (72) days for the failure on the part of the Office to issue the patent within three years of its filing. However, the Office does not assess whether or not any additional PTA is accorded in

¹ Applicant filed the PTA together with payment of the issue fee. In addition, both filings were made timely by the fact that February 25th and February 26th fell on a Saturday and Sunday, respectively. See 37 CFR 1.7(a).

this instance until the issue date is established.²

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **nine hundred (900) days** (972 (50+435+29+458) days of PTO delay and 72 (66+2+4) days of applicant delay).

Receipt of the \$200 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for timely issuance of the patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.



Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

² Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).